

U.S. Parent Application Serial No. 09/888,046
Reply to Office Action mailed June 16, 2005

Remarks:

Applicants have read and considered the Office Action dated June 16, 2005 and the references cited therein. Claims 16, 27 and 44 have been amended to clearly define the invention. New claims 50 and 51 have been added to define further aspects of the invention. Claims 1 to 36 and 38 to 51 are now pending in the present application and are believed to distinguish patentably over the prior art.

In the Official Action, claims 1, 2, 8 to 13, 16 to 19, 21 to 33, 35, 36, 38, 39 and 42 to 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,760,752 to Liu et al. ("Liu") in view of U.S. Patent No. 5,787,169 to Eldridge et al. ("Eldridge"). The Action alleges that the invention as defined by these claims would be obvious to one of ordinary skill in the art in view of the teachings of Liu and Eldridge.

In addition, claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over Liu and Eldridge and further in view of U.S. Patent No. 6,047,259 to Campbell et al. ("Campbell"). The Action alleges that the invention as defined by these claims would be obvious to one of ordinary skill in the art in view of the teachings of these references.

Claims 14, 15, 40 and 41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Liu and Eldridge in view of the publication entitled "A digital watermark technique based on the wavelet transform and its robustness on image compression and transformation" authored by Inoue et al. ("Inoue"). The Action alleges that the invention as defined by these claims would be obvious to one of ordinary skill in the art in view of the teachings of these references. Applicants respectfully submit that the rejections of the claims in view of the cited references are not appropriate for the reasons set forth below.

According to the invention as recited in independent claim 1, Applicants provide a computerized method of creating a data message for electronic transmission to a recipient.

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During the method, at least one image file to be included in the data message is selected. Exchange rights for the recipient are determined. The exchange rights establish at least one action available to the recipient with respect to *subsequent handling of the at least one image file by the recipient*. The at least one image file and the exchange rights are bundled to form the data message.

In contrast, Liu discloses a method and apparatus for transferring a message securely from a sender to a recipient over a network and includes at each transfer: creating a message; retrieving the public key of the recipient from an external key server just prior to sending the message; signing the message using the private key of the sender; encrypting the signed message using a public key encryption and the public key of the recipient producing an encrypted signed message; generating an email message addressed to the recipient; attaching the encrypted signed message as an attachment to the email message; and transmitting the email message to the recipient. As the Examiner correctly notes, Liu is ONLY concerned with transmitting a message between parties securely so that only the authorized recipient has access to the message. Once a message has been safely received by the recipient, the recipient is able to handle the incoming message in any manner seen fit to the recipient as Liu provides no subsequent handling restrictions on the message.

Eldridge discloses a secure system including an unencrypted header file and an encrypted data file containing a list of cryptographically hashed passwords in addition to the data to be secured. The data file contents are encrypted with a single file key. The unencrypted header file contains two tables. The first table is a list of authorized user names and corresponding hashed passwords that have been generated using a hashing technique different than that used to generate the passwords in the data file. The second table is a list of hashed combinations of hashed passwords, where the combinations correspond to authorized user quorums. Each hashed combination is a password key to encrypt the file key.

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During use, an authorized user must enter a password, which when hashed, is in the first table. If the entered password is in first the table, a check is made to determine whether enough authorized users have entered password to form a quorum. If there is a quorum, the passwords of the users are hashed to form a password key allowing the user to access the file.

Similar to Liu, Eldridge is concerned with protecting files so that only authorized users can access the content of protected data files. Eldridge however, does not place any restrictions on the authorized users that limit the users' subsequent handling of the accessed data files.

Applicants respectfully submit that Liu and Eldridge fail to teach or suggest the Applicants' invention as defined. Liu is directed to public key encryption and is not concerned with subsequent handling of a message once transmitted. Eldridge teaches password protection of data files but again, similar to Liu, Eldridge is not concerned with subsequent handling of the data files once a quorum of users have entered passwords. Thus, Liu and Eldridge do NOT determine exchange rights that establish actions available to the recipient with respect to *subsequent handling of the image file by the recipient*. Rather, in the Liu and Eldridge systems, once a file is accessed by a recipient, the recipient is free to handle the file in any manner. There is nothing in the Liu and Eldridge references to suggest assigning exchange rights to data messages to control how accessed files are subsequently handled by recipients. To suggest otherwise is well beyond what Liu and Eldridge teach one of ordinary skill in the art.

On page 5, the Action states that a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Liu in view of Eldridge to arrive at the invention as claimed. The rejection is clearly based on hindsight ex post analysis of the invention as claimed. Such an analysis is clearly forbidden and contrary to well established law and practices. Moreover, Applicants assert that it is impermissible to pick and choose from the relevant prior art to sustain a finding of obviousness while disregarding the teachings of the prior art as a whole. When considering the entirety of Liu and Eldridge, it is clear that these

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references fail to teach or suggest the invention as defined. Neither Liu nor Eldridge is concerned with restricting a user's ability to subsequently handle an accessed file. Rather Liu and Eldridge are only concerned with ensuring an authorized user accesses the file.

Applicants also respectfully submit that neither Campbell nor Inoue, either alone or in combination with Liu and Eldridge, teaches or suggests the Applicants' invention as recited in independent claim 1.

Campbell discloses an interactive method and system for managing physical exams, diagnosis and treatment protocols in health care practice. Physical exam software guides a user through a physical exam, prompting the user for input and dynamically generating context sensitive questions based on prior input. Diagnosis software generates a list of possible diagnoses based on the observations recorded from the physical exam. The user can interactively select a diagnosis by selecting a diagnosis from a rule out list and watching the display as the system dynamic updates the status of unresolved symptoms. The user can also select a treatment protocol, which is integrated with future physical exams. The treatment protocol is integrated such that future exam sessions reflect the status of the treatment protocol and remind the user which services need to be performed and when they should be performed.

Inoue discloses a digital watermark for image signals based on wavelet transform.

Similar to Liu and Eldridge, Campbell and Inoue fail to teach or suggest assigning exchange rights to a data message that establish at least one action available to the recipient with respect to *subsequent handling of the image file*.

In view of the above, Applicants respectfully submit that independent claim 1 distinguishes patentably over Liu, Eldridge, Campbell and Inoue either alone or in combination and should be allowed. As claims 2 to 15, 42 and 43 are dependent either directly or indirectly

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on independent claim 1, which is deemed allowable, Applicants respectfully submit that these claims should also be allowed.

Independent claims 16, 27, 36 and 44 are also believed to distinguish patentably over the cited prior art for the same reasons set forth above. These claims recite rights associated with a file that determine a recipient's rights with respect to subsequent handling of a message. The cited prior art references are not concerned with controlling subsequent handling of accessed files. Accordingly, Applicants respectfully submit that claims 16 to 36 and 38 to 49 distinguish patentably over the cited prior art and should be allowed.

New independent claim 50 recites a computerized method of controlling a user's rights with respect to an accessed image file wherein exchange rights are assigned to a user that define the user's rights with respect to viewing and subsequent handling of an accessed image file. The exchange rights assigned to the user are used to restrict the user's ability to subsequently handle the accessed image file.

As stated above, none of the cited references teach or suggest assigning exchange rights to a user that are used to restrict the user's ability to subsequently handle an accessed file. The prior art is concerned only with restricting access to a file. Accordingly, Applicants respectfully submit that independent claim 50 distinguishes patentably over the prior art and should be allowed. As claim 51 is dependent directly on independent claim 50, which is deemed allowable, Applicants respectfully submit that this claim should also be allowed.

In view of the above, Applicants respectfully submit that the present application is in order for allowance and action to that end is respectfully requested.

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A speedy and favorable action on the merits is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.



Respectfully submitted,

MERCHANT & GOULD P.C.

Dated: 12/15/05

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